

REMARKS/ARGUMENTS

Claims 1-11 are pending in the instant application. Claims 1-11 stand rejected under 35 USC § 112, first paragraph as failing to comply with the written description requirement. Claims 1-11 stand rejected under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 2, 5 and 6 stand rejected under 35 USC § 102 (b) as being anticipated by Ardenkjaer-Larsen et al. (WO 99/35508 and its US equivalent US 6,278,893). Claims 1-11 stand rejected under 35 USC § 102 (b) as being anticipated by Golman et al. (WO 99/24080 and its US equivalent US 6,574,495). The application has been amended.

The specification has been amended to reflect that WO 99/24080 issued as United States Patent No. 6,574,495 on June 03, 2003.

The claims have been amended. Specifically, claim 1 was amended to recite “prior to the injection into a patient” in order to overcome the claim rejections under 35 USC § 102 (b). Basis can be found in the specification as filed, page 11, lines 17-18. Additionally, the numbers included in parenthesis of have been deleted from claims 1 and 7-10 in order to overcome the claim rejections under 35 USC § 112, second paragraph.

Applicants respectfully submit that none of the amendments constitute new matter in contravention of 35 U.S.C. § 132. Reconsideration is respectfully requested.

Claim rejections – 35 USC § 112, first paragraph

Claims 1-11 stand rejected under 35 USC § 112, first paragraph as failing to comply with the written description requirement. Applicants respectfully submit that this rejection stands obviated by the above amendment to the specification.

The specification refers to suitable substrate compounds which may be used in the claimed method to be hydrogenated with para-hydrogen enriched hydrogen as those found in WO 99/24080. The Examiner states that incorporation in the specification by reference to an unpublished U.S. application, foreign application or patent is improper. Applicant respectfully would like to point out that the international publication date of WO 99/24080 is May 20, 1999 which is about three years prior to the present application's priority date (August 29, 2002). Hence the specification includes a reference to a published PCT application (with the US being a designated state) in English language. WO 99/24080 entered national phase from the PCT in the US and resulted in granted US patent number 6,574,495. Applicant has amended the specification referring for the first time to WO 99/24080 by including the term "now issued as United States Patent No. 6,574,495 on June 03, 2003". Reconsideration and withdrawal of the rejection are respectfully requested.

Claim rejections – 35 USC § 112, second paragraph

Claims 1-11 stand rejected under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention due to the inclusion of numbers in parentheses. Applicant respectfully submits that the amendments to claims 1 and 7-10 to delete these numbers obviates this rejection. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim rejection – 35 USC § 102

Claims 1, 2, 5 and 6 stand rejected under 35 USC § 102 (b) as being anticipated by Ardenkjaer-Larsen et al. (WO 99/35508 and its US equivalent US 6,278,893). This rejection is respectfully traversed.

The present invention exposes the contrast agent to an oscillating magnetic field in combination with a stationary magnetic field as part of the contrast agent's production in order to enhance the level of polarization of the contrast agent, i.e. its contrasting effect.

As the Examiner points out, Ardenkjaer-Larsen et al teaches the exposure of a polarized contrast agent to an oscillating magnetic field in combination with a stationary magnetic field. However, Ardenkjaer-Larsen does not teach this in connection with the production of the contrast agent as presently claimed, but in connection with generating MR images and ¹³C-spectra from said polarized contrast agent. That is, Ardenkjaer-Larsen teach to use this technique only after the production and during the application application (after injection into a patient) of the agent.

Moreover, the exposure of a polarized contrast agent to an oscillating magnetic field in combination with a stationary magnetic field according to Ardenkjaer-Larsen et al is not done to enhance the polarization of the contrast agent, it is done to detect NMR signals from said contrast agent, i.e. in connection with generating MR images and ¹³C-spectra from said polarized contrast agent. Thus, as Ardenkjaer-Larsen et al fails to teach exposing a polarized contrast agent to an oscillating magnetic field in combination with a stationary magnetic field in order to enhance the level of polarization of said contrast agent, Applicants respectfully submit that Ardenkjaer-Larsen et al. fails to disclose each and every element of the claimed invention. Therefore the present invention is patentably distinct thereover. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim rejection – 35 USC § 102

Claims 1-11 stand rejected under 35 USC § 102 (b) as being anticipated by Golman et al. (WO 99/24080 and its US equivalent US 6,574,495). This rejection is respectfully traversed.

As noted by the Examiner, Golman et al. teaches the exposure of a polarized contrast agent to an oscillating magnetic field in combination with a stationary magnetic field. However Golman et al, like Ardenkjaer-Larsen et al., only teaches such exposure after the agent has been injected into a patient, not in connection with the production of the contrast agent itself.

Similarly, the exposure of a polarized contrast agent to an oscillating magnetic field in combination with a stationary magnetic field according to Golman et al. is done to detect NMR signals from said contrast agent, i.e. in connection with conventional MR scanning. Thus, exposure of the polarized contrast agent to an oscillating magnetic field in combination with a stationary magnetic field according to Golman et al. is not done to enhance the level of polarization of the contrast agent, i.e. its contrasting effect. Therefore, as Golman et al. fails to disclose each and every element of the present invention, Applicants respectfully submit that the present invention is patentably distinct thereover. Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the amendments and remarks hereinabove, Applicants respectfully submit that the instant application, including claims 1-11, is in condition for allowance. Favorable action thereon is respectfully requested.

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Any questions with respect to the foregoing may be directed to Applicants' undersigned counsel at the telephone number below.

Respectfully submitted,

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